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II. REMARKS RE AMENDMENT TO THE CLAIMS

Independent claims 1, 2 and 6 have been amended to expressly reflect that the sensor module is not moved manually.

No new matter has been added by the amendment of the claims.

III. REPLY TO REJECTION OF CLAIMS 1 and 3-9 UNDER 35 U.S.C. §102(b).

Independent claims 1 and 6, and dependent claims 3-5 and 7-9 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,555,105 (“‘105”) to Shahir, et al. (“Shahir”). In reply Applicant emphasizes that a claim is anticipated if, and only if, each and every element in the claim is found, either expressly or inherently, in a single prior art reference. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571, 7 USPQ2d 1057, 1064 (Fed. Cir. 1988). Applicant will show that no anticipation exists here for the following reasons.

A. Reply Re Independent Claims 1 and 6

The Office Action asserts that independent claims 1 and 6 are anticipated by the ‘105 patent to Shahir. In particular the Office Action asserts that “Shahir teaches a compact business card scanner comprising: a housing; a platen positioned in the housing, the platen having a first surface adapted to support a business card to be scanned, and having a second surface opposed to the first surface (Ref 8); a sensor module mounted within the housing, adapted for reciprocal motion within the housing and adapted to convert an optical image of a scanned business card into digital data representative of said optical image (Ref 2); and a display device 10 positioned in the housing and adapted to display a graphic image of the scanned business card (Col 2 lines 39-49; Col 4 lines 1-29; Fig 1).” In fact, Shahir does not anticipate the presently claimed invention, as is explained below.

Shahir '105 discloses "A business card may be inserted within the device, copied by operation by manually manipulating a scanner device" [sic] at Column 2, lines 27-29, and "In use the scanner slider knob 7 is manually manipulated in order to effect movement of the scanner copier head 21." at Column 3, lines 10-12. However, independent claims 1 and 6, as currently amended, expressly require that the sensor module of the presently claimed invention be moved by a motor. Shahir '105 does not disclose or teach use of a motor or other non-manual means to affect scanning.

Applicant reemphasizes that a claim is anticipated if, and only if, each and every element in the claim is found, either expressly or inherently, in a single prior art reference. As the Shahir '105 reference fails to disclose every element of independent claims 1 and 6, as currently amended, the requirement of anticipation has not been met. Applicant submits that the rejection of claims 1 and 6 under 35 U.S.C. §102(b) has been overcome and should be withdrawn.

B. Reply Re Dependent Claims 3/1, 4/1, 5/1, 7/1, 8/7/1 and 9/7/1

Dependent claims 3/1, 4/1, 5/1, 7/1, 8/7/1 and 9/7/1 depend from independent claim 1 as presently amended. The facts and argument offered in reply to the rejection of independent claim 1 are incorporated by reference herein in reply to the rejection of dependent claims 3/1, 4/1, 5/1, 7/1, 8/7/1 and 9/7/1.

Therefore, the rejection of dependent claims 3/1, 4/1, 5/1, 7/1, 8/7/1 and 9/7/1 under 35 U.S.C. § 102(b) has been overcome and should be withdrawn.

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IV. REPLY TO REJECTION OF CLAIMS 2, 10 and 11 UNDER 35 U.S.C. §103(a).

Claims 2, 10 and 11 have been expressly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,555,105 (“105”) to Shahir, et al. (“Shahir”) in view of U.S. Patent No. 6,032,866 (“866”) to Knighton, et al. (“Knighton”), or in view of U.S. Patent No. 6,650,761 (“761”) to Rodriguez, et al. (“Rodriguez”). The Office Action impliedly, although not expressly, also rejects dependent claims 3, 4, 5 and 7-11 which depend from independent claim 2. The impliedly rejected dependent claims are claims 3/2, 4/2, 5/2, 7/2, 8/7/2, 9/7/2, 10/7/2 and 11/7/2.

According to the Office Action, “Shahir discloses the business card reader as discussed above. Shahir does not disclose expressly a first housing and a second housing movably attached to said first housing. Knighton discloses a first housing and a second housing movably attached to said first housing (Col 2 lines 24-38; Fig 1). Knighton & Shahir are combinable because they are from the same field of endeavor and employ business cards. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Knighton with Shahir. The suggestion/motivation for doing so would have been to provide a compact image reader. Therefore, it would have been obvious to combine Knighton with Shahir to obtain the invention as specified in claim 2.”

Applicant strongly disagrees with the unsupported assertion in the Office Action that “Knighton & Shahir are combinable because they are from the same field of endeavor and

employ business cards.” Nonetheless, because the rejection is overcome here on other grounds, Applicant reserves the right to argue this issue should it be asserted in a subsequent Office Action.

Applicant would emphasize in reply that in order to establish prima facie obviousness it is required: (1) that there be some evidence in the reference or prior art suggesting or showing why a particular modification would be made to a prior art device or process so that the combined teachings of the cited prior art teach all of the claim limitations, *In re Royka*, 490 F.2d 981, 985, (CCPA 1974); and (2) that the references be properly combinable or modifiable, and not teach away from the invention, *In re Gordon*, 733 F.2d 900, 902, (Fed.Cir. 1984). To render the invention of claims 2, 3/2, 4/2, 5/2, 7/2, 8/7/2, 9/7/2, 10/7/2, 11/7/2, 10 and 11 obvious, the prior art references must teach all limitations of claims 2, 3/2, 4/2, 5/2, 7/2, 8/7/2, 9/7/2, 10/7/2, 11/7/2, 10 and 11, including the limitation of “a sensor module mounted within the first housing, adapted to be moved by a motor under the platen and adapted to convert an optical image of a scanned business card into digital data representative of said optical image;”.

A. Reply Re Independent Claim 2

In response, Applicant points out that independent claim 2 as amended contains the limitation “a sensor module mounted within the first housing, adapted to be moved by a motor under the platen and adapted to convert an optical image of a scanned business card into digital data representative of said optical image;” Applicant reemphasizes that Shahir

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‘105 contains no disclosure of and does not claim, that its scanner copier head is moved by other than manual means. Rather, Shahir ‘105 (at column 1, lines 56-57; column 2, lines 27-29; column 3, lines 10-12; and column 4, lines 17-19) teaches only that its scanner copier head (21) is manually moved, and thus Shahir ‘105 cannot and does not provide any suggestion or motivation for this limitation of independent claim 2 as amended.

Applicant points out that Knighton ‘866 contains no disclosure of and does not claim, a sensor module mounted within a housing, adapted to be non-manually moved under a platen as is presently and affirmatively claimed in independent claim 2 as amended, and thus cannot and does not provide any suggestion or motivation for the present claim limitation. Applicant further points out that Rodriguez ‘761 contains no disclosure of and does not claim, a sensor module mounted within a housing, adapted to be non-manually moved under a platen as is presently and affirmatively claimed in independent claim 2 as amended, and thus cannot and does not provide any suggestion or motivation for the present claim limitation.

For the foregoing reasons, it is submitted that prima facie obviousness of independent claim 2, as amended, has not been established and that the rejection under 35 U.S.C. §103(a) should be withdrawn.

B. Reply Re Dependent Claims 3/2, 4/2, 5/2, 7/2, 8/7/2, 9/7/2, 10/7/2 and 11/7/2

Dependent claims 3/2, 4/2, 5/2, 7/2, 8/7/2, 9/7/2, 10/7/2 and 11/7/2 depend from independent claim 2. If an independent claim is nonobvious under 35 U.S.C. §103, than any

claim depending therefrom is likewise nonobvious. See, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998). See also, *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). Accordingly, because it has been shown that independent claim 2 is nonobvious, the facts and argument offered in reply to the rejection of claim 2 would be offered in reply to an express rejection of claims 3/2, 4/2, 5/2, 7/2, 8/7/2, 9/7/2, 10/7/2 and 11/7/2 if made on the same grounds as was the rejection of independent claim 2. It necessarily follows that dependent claims 3/2, 4/2, 5/2, 7/2, 8/7/2, 9/7/2, 10/7/2 and 11/7/2 are also nonobvious.

Therefore, the implied rejection, if any, of dependent claims 3/2, 4/2, 5/2, 7/2, 8/7/2, 9/7/2, 10/7/2 and 11/7/2 under 35 U.S.C. § 103(a) has been overcome and should be withdrawn.

C. Reply Re Dependent Claims 10 and 11

Dependent claims 10 and 11 depend from dependent claim 7 which depends from independent claim 1 or independent claim 2. If an independent claim is nonobvious under 35 U.S.C. §103, than any claim depending therefrom is likewise nonobvious. See, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998). See also, *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). Accordingly, because it has been shown that independent claim 2 is nonobvious, the facts and argument offered in reply to the rejection of claim 2 are incorporated by reference herein in reply to the rejection of claims 10 and 11 and it necessarily follows that dependent claims 10 and 11 are also nonobvious.

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Therefore, the rejection of dependent claims 10 and 11 under 35 U.S.C. § 103(a) has been overcome and should be withdrawn.

VI. CONCLUSION

For the foregoing reasons, it is believed that the application is now in condition for allowance.

The Commissioner is authorized during the prosecution of this application to charge fees that may be required or credit any overpayment of fees to Deposit Account No. 50-1215, except for payment of patent issue fees required under 37 CFR § 1.18. Please show our above-referenced number with any credit or charge to our Deposit Account.

Respectfully submitted,

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